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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/807,975
Filing Date: March 24, 2004
Appellant(s): RAITH ET AL.

_____

Michael D. Murphy
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on November 11, 2008 appealing from the

Office action mailed on March 28, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The summary of claimed subject matter contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2004/0111476 A1   Trossen et al.   Jun 10, 2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-14 and 26-30 are rejected as being indefinite under 35 USC 112,

second paragraph.

Claims 1-4, 9-13, 15-16, 18-20, and 31-32 are rejected under 35 USC 102(e) as

being anticipated by Trossen et al. (US 2004/0111476).

Claims 5-8, 17 and 21 are rejected under 35 USC 103(a) as being obvious over

Trossen et al. (US 2004/0111476).

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

2.   Claims 1-14 and 26-30 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

3.   Where applicant acts as his or her own lexicographer to specifically define a term

of a claim contrary to its ordinary meaning, the written description must clearly redefine

the claim term and set forth the uncommon definition so as to put one reasonably skilled

in the art on notice that the applicant intended to so redefine that claim term. *Process

Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed.

Cir. 1999). The term "default" in claims 1 and 26 is used by the claim to mean "a format

suitable for a particular destination address", while the accepted meaning is "in the

absence of," Webster's Collegiate Dictionary. Thus, the term "default" would be applied

consistent with its accepted meaning if the default format was applied to a destination

address when no other format was designated. Since the claims appear to require that

the "default format" be specified for certain destination addresses, the term "default" is

indefinite because the specification does not clearly redefine the term. For purposes of

prior art rejections, Examiner will treat the "default format" to be a format suitable for a

destination address. Examiner notes that this interpretation does not work in claims 14

and 26 since it would require a determination of the transcoding to be performed, and

then require an additional determination of the transcoding to be performed, where this

transcoding would have been determined in the previous determination step.

Therefore, Examiner will not make any prior art rejection for claims 14 and 26-30.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1-4, 9-13, 15, 16, 18-20, 22-23, 25, and 31-33 are rejected under 35

U.S.C. 102(e) as being anticipated by Trossen et al. (US 2004/0111476).

6.   Regarding claims 1 and 31, Trossen discloses a method of and apparatus for

processing multimedia messages outgoing from an originating network, the method

comprising the steps of and the apparatus comprising means for: selectively

transcoding multimedia content in outgoing multimedia messages from a current format

into a default format as a function of their destination network addresses (¶ [0034],

where "one or more recipient rules can be defined such that the media content is

transcoded", and ¶ [0036], where the recipient rules can be associated with the

respective recipients based on addressing information); and sending the messages

according to their destination network addresses (¶ [0029], where the message is sent

to a user).

7.   Regarding claim 2, Trossen discloses that selectively transcoding multimedia

content in outgoing multimedia messages from a current format into a default format as

a function of their destination network addresses comprises performing transcoding for

messages targeted to email addresses (¶ [0002], where MMS allows the use of email,

and ¶ [0036], where "addressing information" is generically specified, such that it

includes email addresses, see also ¶¶ [0065]- [0067], where an exemplary rules

database performs certain functions based on email addresses).

8.   Regarding claim 3, Trossen discloses that selectively transcoding multimedia

content in outgoing multimedia messages from a current format into a default format as

a function of their destination network addresses comprises not performing transcoding

for messages not targeted to email addresses (¶ [0034], where "one or more recipient

rules can be defined such that the media content is transcoded", and ¶ [0036], where

the recipient rules can be associated with the respective recipients based on addressing

information, such that users can specify not to perform transcoding on messages not targeted to email addresses).

9.   Regarding claim 4, Trossen discloses selectively transcoding multimedia content in outgoing multimedia messages from a current format into one or more specified formats as a function of their destination network addresses (¶ [0034], where "one or more recipient rules can be defined such that the media content is transcoded", and ¶ [0036], where the recipient rules can be associated with the respective recipients based on addressing information).

10.   Regarding claim 9, Trossen discloses that the originating network comprises a first wireless communication network (Fig. 2 and ¶¶ [0025]-[0027], where the originating network is wireless communication network, ref. 212), and wherein sending the messages according to their destination network addresses comprises sending the messages from one or more Multimedia Messaging Services (MMS) servers in the first wireless communication network (Fig. 2 and ¶¶ [0025]-[0027], where the messages are send from MMS, ref. 214, in the originating network).

11.   Regarding claim 10, Trossen discloses that selectively transcoding multimedia content in outgoing multimedia messages from a current format into a default format as a function of their destination network addresses comprises performing default transcoding for outgoing messages targeted to Internet domains and not performing default transcoding for outgoing messages targeted to wireless network domains (¶ [0034], where "one or more recipient rules can be defined such that the media content is transcoded", and ¶ [0036], where the recipient rules can be associated with the

respective recipients based on addressing information, such that the rules can be set in

a manner in which "default transcoding" is performed for messages destined to IP

domains and no "default transcoding" is performed for messages destined for wireless

networks, see also ¶¶ [0046]-[0047]).

12.   Regarding claim 11, Trossen discloses for outgoing messages targeted to

wireless network domains, determining whether transcoding is desired for a particular

outgoing message targeted to a particular wireless network domain, and, if so,

transcoding at least a portion of the multimedia content in that message into a format

specified for that particular wireless network domain (¶ [0034], where "one or more

recipient rules can be defined such that the media content is transcoded", and ¶ [0036],

where the recipient rules can be associated with the respective recipients based on

addressing information, see also ¶¶ [0046]-[0047]).

13.   Regarding claim 12, Trossen discloses that determining whether transcoding is

desired for a particular outgoing message targeted to a particular wireless network

domain comprises determining whether a database identifies that particular network as

one for which transcoding is desired (¶¶ [0046]-[0047], where a network rule is checked

to see if transcoding is required for a particular network, see also ¶¶ [0034],[0036]).

14.   Regarding claim 13, Trossen discloses identifying from information stored in the

database the format specified for that particular network (¶¶ [0046]-[0047], where a

network rule is checked to see if transcoding is required for a particular network, see

also ¶¶ [0034],[0036]).

15.   Regarding claims 15 and 32, Trossen discloses a method of and apparatus for
processing multimedia messages outgoing from an originating network, the method
comprising the steps of and the apparatus comprising means for: sending destination
address information for an outgoing multimedia message from a first entity to a second
entity (¶ [0023], where the user databases, i.e. a second entity, store the rules, and ¶
[0036], where the rules are stored according to address, such that to obtain a rule the
processing element (the MMS server or rule processor as taught in ¶ [0024]), i.e. the
first entity, would have to retrieve the rule from the user database, see also ¶ [0060],
where the rule processor determines "whether any stored recipient rules are associated
with the recipient of the [message]"); receiving at the first entity a corresponding
indication from the second entity as to whether multimedia content transcoding is
desired for the message (¶ [0023], where the processing element, i.e. the first entity, will
receive the rule from the user database, i.e. the second entity, and ¶ [0034], where the
rules deal with transcoding, see also ¶ [0060]); selectively performing transcoding at the
first entity based on the indication (¶ [0060], where the rule processor performs the
transcoding, see also ¶ [0034]); and sending the message from the first entity for
delivery to the destination address (¶ [0029], where the message is sent to a user, and
¶ [0024], where the rules may be executed by the MMS server, which is also the device
that transmits the message to the user).

16.   Regarding claim 16, Trossen discloses that the second entity is external to the
originating network (Fig. 2, where the originating network is ref. 212 and the database is

stored in ref. 220, i.e. the database storing the rules is in the destination network, see
also ¶ [0059]).

17.   Regarding claim 18, Trossen discloses that the originating network comprises a
first wireless communication network (Fig. 2 and ¶¶ [0025]-[0027], where the originating
network is wireless communication network, ref. 212), and wherein sending destination
address information for an outgoing multimedia message from a first entity to a second
entity comprises sending an indication of a destination mobile telephone number
targeted by the message (¶ [0036], where the rules are stored according to destination
address, such as a telephone number).

18.   Regarding claim 19, Trossen discloses receiving from the first entity a
corresponding indication from the second entity as to whether multimedia content
transcoding is desired for the message comprises receiving an indication from the
second entity that identifies a desired format for transcoding at least a portion of the
multimedia content in the message (¶ [0034], where it is implicit that the rule stores the
desired format for the transcoding).

19.   Regarding claim 20, Trossen discloses that selectively performing transcoding at
the first entity based on the indication comprises determining whether the corresponding
indication returned by the second entity indicates that transcoding is desired and, if so,
transcoding at least a portion of the multimedia content in the message into the desired
format (¶ [0034], where the message is transcoded if the rule dictates that transcoding
is desired).

20.   Regarding claims 22 and 33, Trossen discloses a method of and apparatus for
processing multimedia messages outgoing from an originating network, the method
comprising the steps of and the apparatus comprising means for: forwarding an
outgoing multimedia message from a first entity to a second entity (¶ [0059], where the
MMS server, i.e. the first entity, passes a received message to a rule processor, i.e. a
second entity); receiving the message back from the second entity at the first entity,
after the second entity has subjected the message to selective transcoding of
multimedia content in the message (¶ [0059], where the MMS server, i.e. the first entity,
receives the message back from the rule processor, i.e. a second entity, after the rule
processor has executed rules, and ¶ [0061], where the rules include transcoding, see
also ¶¶ [0034],[0036]); and sending the message from the first entity for delivery to the
destination address (¶ [0059], where the MMS server, i.e. the first entity, delivers the
message content).

21.   Regarding claim 23, Trossen discloses that the second entity is external to the
originating network (Fig. 2, where the originating network is ref. 212 and the database is
stored in ref. 220, i.e. the database storing the rules is in the destination network, see
also ¶ [0059]).

22.   Regarding claim 25, Trossen discloses that the second entity selectively
performs transcoding of multimedia content in the message by determining whether
transcoding is desired for the message based on a destination address of the message
and, if transcoding is desired, transcoding at least a portion of multimedia content in the
message from a first coding format into a second coding format (¶ [0034], where "one or

more recipient rules can be defined such that the media content is transcoded", and ¶

[0036], where the recipient rules can be associated with the respective recipients based

on addressing information).

Claim Rejections - 35 USC § 103

23.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

24.   Claims 5-8, 17, and 21 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Trossen et al. (US 2004/0111476).

25.   Regarding claim 5, Trossen discloses that selectively transcoding multimedia

content in outgoing multimedia messages from a current format into one or more

specified formats as a function of their destination network addresses comprises

determining that an outgoing message is targeted to a particular address, and

transcoding at least a portion of the multimedia content in the message into a format

specified for the targeted address (¶ [0034], where "one or more recipient rules can be

defined such that the media content is transcoded", and ¶ [0036], where the recipient

rules can be associated with the respective recipients based on addressing

information).

        Trossen does not expressly disclose that the particular address is related to a

particular wireless network domain. However, Trossen does disclose specifying a

particular type of message be delivered over a particular type of network (¶ [0046],

where a rule can be defined that requires media content to be delivered over a given type of network, and where the networks are wireless networks), where the type of network may require a specific format for delivery (¶ [0047], where the network may require transcoding). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to determine that an outgoing message is targeted to a particular wireless network domain and transcoding at least a portion of the content in the message into a format specified for the targeted wireless network domain to ensure that the message is delivered over a given network in a format appropriate for that network.

26.   Regarding claim 6, Trossen discloses that determining that an outgoing message is targeted to a wireless network domain comprises identifying a targeted mobile telephone number for the outgoing message (¶ [0036], where addresses can be telephone numbers) and identifying a name of the wireless network domain based on accessing an ENUM database that associates mobile station telephone numbers with particular wireless network domains (¶ [0046], where the rules database, i.e. an ENUM database, implicitly associates the telephone number with particular domains, e.g. 2G mobile networks or 3G mobile networks, since the type of network is identifies based on the incoming message, which includes destination telephone number).

27.   Regarding claim 7, Trossen discloses that selectively transcoding multimedia content in outgoing multimedia messages from a current format into one or more specified formats as a function of their destination network addresses comprises transcoding audio content in the outgoing message from a first audio coding format

associated with the originating communication network into a second audio coding format specified for the targeted wireless network domain (¶¶ [0046]-[0047], where a rule can be defined that requires media content to be transcoded before delivery over a given type of network).

28.   Regarding claim 8, Trossen does not expressly disclose that the originating network comprises either a GSM wireless communication network, or a cdma2000 wireless communication network, and the targeted wireless network domain corresponds either to a GSM wireless communication network, or to a cdma2000 wireless communication network. However, Trossen does disclose that the originating network is a 2G mobile network or a 3G mobile network and that the destination network is a 2G mobile network or a 3G mobile network (¶ [0046]). Examiner takes official notice that GSM is a well-known 2G wireless communication protocol and that cdma2000 is a well known 3G wireless communication protocol. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have the originating network comprise either a GSM wireless communication network, or a cdma2000 wireless communication network, and the targeted wireless network domain corresponds either to a GSM wireless communication network, or to a cdma2000 wireless communication network to increase the industrial applicability of Trossen's system by allowing it to operate over commonly used wireless communication protocols.

29.   Regarding claim 17, Trossen does not expressly disclose that sending destination address information for an outgoing multimedia message from a first entity to a second entity comprises forwarding the message from the first entity to the second

entity, and wherein the message includes the destination address information.

However, Trossen does disclose sending the entire message to a second entity when

the entity processes the message (¶ [0059]). Trossen also discloses that the rules may

be retrieved according to any of a number of manners (¶ [0036]), such that rules may be

retrieved based on more information than just the destination address information.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to send to the second entity the entire message to allow the second entity to

retrieve from the message the pertinent information needed to retrieve the pertinent

rule.

30.   Regarding claim 21, Trossen does not expressly disclose that sending the

message from the first entity for delivery to the destination address comprises sending

the message to a multimedia server in a destination network for subsequent delivery to

a targeted recipient. However, Trossen does disclose that a first MMS server in an

originating network will send the message to a second MMS server in a destination

network (¶¶ [0056]-[0059]). Trossen also discloses that the rules may be used to

provide more efficient communication over a network (¶ [0045]). Therefore, it would

have been obvious to one of ordinary skill in the art at the time of the invention to send

the message to a multimedia server in a destination network for subsequent delivery to

a targeted recipient to enable the message to be delivered in a manner in which efficient

communication can be utilized over the network connecting the originating and

destination multimedia servers.

(10) Response to Argument

Regarding applicant's argument to the definition of the word "default" to mean "a selection made usually automatically or without active consideration due to a lack of viable alternative" or "a selection automatically used by a computer program in the absence of a choice made by a user", even if said definition is applied, it would contradict applicant's claims. Applicant is reminded that independent claims 1, 26 and 31 call for: "**selectively** transcoding multimedia messages from **a current format into a default format** as a function of their destination network addresses", meaning that the transcoding is not done automatically as would be required by applicant's definition of "default" but rather as a choice. The examiner also emphasizes that the "default format" is being treated as "a format suitable for that particular destination address".

31.   Claim 1 recites: "selectively transcoding multimedia content in outgoing multimedia messages from a current format into a default format as a function of their destination network addresses." Here, the claim only requires the selection of a default format as a function of a destination network address. There is no mention that another format could be selected, where the selection of the default format only occurs when the another format is not available. Thus, the claim requires that every selection of a format also be the selection of a "default format." The use of the term "default" in this context renders the metes and bounds of the claim vague and indefinite.

32.   Applicant goes on to assert that "its use of the term 'default' in the rejected claims is abundantly clear to those skilled in the art, in view of the specification." Response: p. 14. Examiner respectfully disagrees. As outlined above, the use of the term "default" in

the claims is inconsistent with the plain meaning of the term. While Examiner

recognizes that Applicant can act as his or her own lexicographer to specifically define a

term of a claim contrary to its ordinary meaning, the written description must clearly

redefine the claim term and set forth the uncommon definition so as to put one

reasonably skilled in the art on notice that the applicant intended to so redefine that

claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52

USPQ2d 1029, 1033 (Fed. Cir. 1999). Examiner cannot find any place in the

Specification where Applicant has redefined the term "default" by setting forth a

definition so as to put one reasonably skilled in the art on notice that Applicant has

redefined the term. In view of the foregoing, Examiner asserts that Applicant's use of

the term "default" in the claims is inconsistent with how one of ordinary skill in the art

would understand the term, even when the claim is read in light of the specification.

33.   Regarding the anticipation rejections under 35 U.S.C. § 102(e), the Examiner

maintains that the definitions proffered by Applicant create ambiguities within the claims,

such that Examiner is required to interpret the claim in a manner that renders the prior

art applicable. *Ex Parte Ionescu,* 222 USPQ at 539. *See also* MPEP § 2143.03. If

Applicant does not agree with the definition that Examiner used for the term "default"

then Applicant is free to clearly define the term in the claims – provided that this

definition results in the "claims particularly pointing out and distinctly claiming the

subject matter which the application regards as his invention," as required by 35 U.S.C.

§ 112, second paragraph.

34.   Applicant then discusses various teachings in the Specification which Applicant
asserts "exemplifies" the meaning of "default" and "specific." Applicant is reminded that,
although the claims are interpreted in light of the specification, limitations from the
specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26
USPQ2d 1057 (Fed. Cir. 1993). Here, Applicant has failed to *explicitly* define the terms
"default" and "specific" in the Specification. As such, it is inappropriate for Examiner to
read in Applicant's "exemplifications" from the Specification to define the terms in the
Specification. Further, Examiner maintains that, even if Examiner could read in these
limitations from the Specification, the claims would continue to be vague and indefinite
under 35 USC § 112, second paragraph, such that Examiner would be required to
interpret the claims to apply the prior art, because, as outlined above, Applicant's
asserted definitions set up ambiguities in the claims.

35.   Finally, Applicant asserts that Trossen does not disclose the use of the claimed
default format. Examiner maintains that Trossen anticipates the claims in light of the
definition given to "default" by Examiner. In view of the foregoing, Examiner maintains
that the claims are vague and indefinite, such that Examiner is required to interpret the
claim in a manner that renders the prior art applicable. *Ex Parte Ionescu,* 222 USPQ at
539. *See also* MPEP § 2143.03. If Applicant does not agree with the definition that
Examiner used for the term "default" then Applicant should amend the claims to resolve
these ambiguities.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Farah Faroul/

Examiner, Art Unit 2416

Conferees:

/FIRMIN BACKER/

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